



DPW

I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as First Class Mail, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: January 3, 2006

Signature: Scott E. Baxendale  
(Scott E. Baxendale)

Docket No.: 29498/38561A  
(PATENT)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:  
Alejandro Rossato et al.

Confirmation No.: 9953

Application No.: 10/698,554

Filed: October 31, 2003

Art Unit: 3634

For: TEMPORARY WINDOW COVERING

Examiner: Purol, David M.

**RESPONSE TO RESTRICTION AND ELECTION REQUIREMENT**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This paper is being presented pursuant to 37 C.F.R. § 1.143 and in response to an Official action dated October 3, 2005, wherein pending claims 1-46 were subjected to a three-way restriction requirement. Specifically, the action defines the restriction based on the embodiments illustrated in the drawing figures as follows:

Species I: Fig. 1;

Species II: Figs. 2-10; and

Species III: Figs. 11-28.

See the Action at p. 2. The restriction requirement is traversed, and reconsideration and withdrawal of the restriction requirement are respectfully requested in view of the following remarks.

**I. The Restriction Requirement Is Traversed**

**A. The Restriction**

As bases for the restriction, the Office action alleges in conclusory fashion that the three groups of invention are distinct from one another, as follows:

This application contains claims directed to the following patentably distinct species of the claimed invention: Species I of the temporary window covering drawn to figure 1; Species II of the temporary window covering drawn to figures 2-10; Species III of the temporary window covering drawn to figures 11-28.

Action at p. 2. The Office action does not provide reasons and/or examples to support the conclusion that the drawing figures show patentably distinct species, but the Office action further states that “[c]urrently, no claims are generic.” *Id.*

**B. The Office Action Does Not Provide Reasons and/or Examples to Support the Conclusion that the Embodiments are Patentably Distinct Species**

For a restriction to be proper, the requirement for restriction must provide reasons and/or examples to support the conclusions. *See M.P.E.P. § 803 (8<sup>th</sup> Ed., rev. 3, Aug. 2005).* The restriction requirement is traversed because there is no demonstration that both applicable criteria for distinctness among the claims. The requirement only states that the embodiments shown in the drawings are distinct. Absent the required support for the conclusion that distinctness among the claims exists, applicants respectfully request withdrawal of the requirement for restriction.

**C. Search and Examination of the Entire Application Can Be Made Without Serious Burden on the Examiner**

According to the M.P.E.P., for restriction to be proper, search and examination of the entire application must impose a serious burden on the examiner. *See M.P.E.P. § 803 (8<sup>th</sup> Ed., rev. 3, Aug. 2005)* (“If the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though

they include claims to independent or distinct inventions.”). The restriction requirement is traversed because there is no evidence that search and examination of the entire application would impose a serious burden on the PTO.

A serious burden on the examiner may be shown by an appropriate explanation of separate classification, separate status in the art, or a different field of search, among other reasons, but the Office action provides no explanation whatsoever of any burden on the examiner necessitating restriction of the claims. Indeed, the Office action does not even allege that there would be a serious burden. The claims corresponding to the figures identifying Species II and III are concerned with similar subject matter (e.g., a temporary window shade having a bottom rail with a slot for engaging a cord to support the weight of the bottom rail and accumulated portion of a cover, and a temporary window shade including a similar bottom rail that is reconfigurable between a first position encircling a pleated cover and a second position that does not encircle the pleated cover and allows the cover to be repositioned). Moreover and contrary to the assertion in the Office action, at least independent claims 23 and 36 are generic with respect to Species II and III. Accordingly, a complete search directed to the subject matter recited in the claims of Species II or III likely includes a search directed to the subject matter recited in the claims of either of these Species.

Because search and examination of the entire application can be made without serious burden on the PTO, it would be wasteful of the time, effort, and resources of both the applicants and the PTO to prosecute claims directed to the product and a process of using the product in separate applications. Furthermore, if the restriction requirement is maintained, the applicants will likely incur additional prosecution costs associated with filing one or more divisional applications, and the PTO will be required to perform duplicative searches. Thus, withdrawal of the restriction requirement will actually *reduce* the burden on the PTO and on the applicants.

**D. Admissions Concerning the Patentability of the Claims Result if the PTO Maintains the Restriction Requirement**

If the restriction requirement is maintained, then the U.S. Patent and Trademark Office (“PTO”) admits that the embodiment in each group of drawing figures is patentable over the disclosure of each of the other embodiments in each of the other groups of drawing figures. *See, e.g.*, M.P.E.P. § 802.01 (8<sup>th</sup> Ed., rev. 3, Aug. 2005). These admissions are necessary to the PTO’s entry of the restriction requirement and may be relied upon by the applicants during examination of this application and future divisional applications, unless the restriction requirement is withdrawn. If the PTO is not making these admissions regarding patentability, then the restriction requirement should be withdrawn.

The restriction requirement also should be withdrawn because the restriction may present potential double patenting. According to the M.P.E.P., the patent statute (e.g., 35 U.S.C. § 121):

prohibits the use of a patent issuing on an application with respect to which a requirement for restriction has been made, or on an application filed as a result of such a requirement, as a reference against any divisional application, if the divisional application is filed before the issuance of the patent. The 35 U.S.C. 121 prohibition applies only where the Office has made a requirement for restriction. ... This apparent nullification of double patenting as a ground of rejection or invalidity in such cases imposes a *heavy burden* on the Office to guard against erroneous requirements for restrictions where the claims define essentially the same invention in different language and which, if acquiesced in, might result in the issuance of several patents for the same invention.

*See* M.P.E.P. § 804.01 (8<sup>th</sup> Ed., rev. 3, Aug. 2005) (emphasis added). The applicants respectfully request reconsideration and withdrawal of the restriction requirement in view of the foregoing admonitions.

In view of the foregoing, the applicants respectfully request reconsideration and withdrawal of the restriction requirement.

**II. Provisional Election**

Pursuant to the requirements of 37 C.F.R. § 1.143, the applicants hereby elect the subject matter recited in claims 1-46 (Species III - Figs. 11-28) for further prosecution. Should the Examiner disagree that each of the pending claims reads on the subject matter identified in the Office action as Species III, applicants respectfully request that the Examiner either contact the undersigned directly or provide an explanation of the reasons why any of the pending claims do not read on the subject matter of Species III.

**III. Conclusion**

Should the examiner wish to discuss the foregoing, or any matter of form or procedure in an effort to advance this application to allowance, he is urged to contact the undersigned attorney.

Dated: January 3, 2006

Respectfully submitted,

By: Scott E. Baxendale  
Scott E. Baxendale  
Registration No.: 41,605  
MARSHALL, GERSTEIN & BORUN LLP  
233 S. Wacker Drive, Suite 6300  
Sears Tower  
Chicago, Illinois 60606-6357  
(312) 474-6300  
Attorneys for Applicants